

### **REMARKS/ARGUMENTS**

Entry of the foregoing amendment, pursuant to the provisions of 37 CFR §1.116, and reconsideration of this application, in view of the foregoing amendment and the following remarks and arguments, are respectfully requested.

Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 are currently pending in this application. By the foregoing amendment, clarifying revisions have been made to Claims 5 and 6. Accordingly, Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 remain in this application for reconsideration and allowance.

In his January 21, 2004 Final Office Action, the Examiner made the following rejections which are respectfully traversed for reasons subsequently set forth herein.

1. Claims 10, 15, 84 and 91-97 stand finally rejected under 35 USC §103(a) as being unpatentable over U.S. Patent 6,478,091 to Gano in view of U.S. Patent 4,683,944 to Curlett;

2. Claim 87 stands finally rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 6,227,303 to Jones;

3. Claim 88 stands finally rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett and Jones, further in view of U.S. Patent 5,392,862 to Swearingen;

4. Claim 89 stands finally rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 6,505,682 to Brockman;

5. Claim 5 stands finally rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, Brockman and Jones;

6. Claim 6 stands finally rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, Brockman and Jones, further in view of Swearingen;

7. Claims 8 and 90 stand finally rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 3,099,318 to Miller et al; and

8. Claim 85 stands finally rejected under 35 USC §103(a) as being unpatentable over Gano in view of Curlett, further in view of U.S. Patent 3,712,373 to Bearden et al.

All of the rejected claims, in one manner or another, set forth a well screen comprising a plurality of telescoped tubular members including an innermost perforated tubular member having a line embedded in its sidewall. Representatively, this claimed subject matter is cross-sectionally illustrated in FIG. 2 of the present applicants' drawings.

With respect to the Gano/Curlett reference combination used (in combination with various secondary references as to some of the pending claims), the Examiner contends that it would be obvious to form the embedded conduits/lines 372 in the Curlett casing 366 (see Curlett FIGS. 24 and 25) in the innermost tubular member 74 in the well screen structure cross-sectionally depicted in FIGS. 5A and 5B in Gano. According to the Examiner, the motivation for this substitution would be to (1) provide electrical parameter sensors for well management purposes and to gather information relating to the subterranean formation, and (2) protect the lines from the high pressure conditions that may exist downhole.

The combination of the Gano and Curlett references which is pivotal to the Examiner's obviousness rejections of all of the claims pending in this application cannot properly be made since (1) there is **no motivation** for making the combination, (2) each of the Gano and Curlett references, in addition to the Brockman reference used in the Examiner's obviousness rejection of Claims 5, 6 and 89, teaches **directly away from** the proposed combination thereof.

In FIGS. 5A and 5B of Gano referred to by the examiner, lines 83 are embedded within a chamber 81 of one of a circumferentially spaced series of longitudinally elongated compressible sealing strips 84 disposed in an annulus between the inner tubular member 74 of the well screen structure and the outer tubular member. Beginning on line 17 of column 6 of Gano it is stated that:

In this manner, the lines 83 may be easily and conveniently attached to the exterior of the tubular structure 74 while it is being run into the well. That is, the lines 83 are snapped into the longitudinal channel 81 as the tubular structure 74 is lowered into the well.

Thus, for ease in installation of the lines 83 in the Gano well screen the lines 83 are positioned **outside** the innermost tubular member in the sealing strip members 84 (as opposed, for example, to attempting to place them in the side wall of the innermost tubular member 74). Thus, Gano specifically teaches **directly away from** embedding the lines 83 in the side wall material of the innermost tubular member 74. It should be further noted that the resilient strip 84 which houses the lines 83 also **protects** them.

Curlett also teaches **directly away from** embedding a line in an innermost perforated tubular member in a plurality of telescoped tubular members. In the Curlett casing 366 referred to by the examiner (see FIGS. 24 and 25), the longitudinal flow passages 372 in the tubular casing 366 are formed inwardly adjacent the **outermost** side wall of a **single** tubular member which is **directly** exposed to fluid in a wellbore. There is no tubular member within the casing 366. Additionally, the casing 366 is not **perforated**. Further, the casing is not part of a **filtering** structure - the only filtering structure is the circular mesh screen 408 (FIG. 26) at the open bottom end of the casing. It clearly would not be obvious to perforate the casing 377 since well fluid and entrained sand could then bypass

screen 408 and enter the pump section 406. Curlett thus teaches the extension through an **outermost** portion of an tubular structure, which is of an **imperforate** construction, of fluid passages, with the tubular casing 366 **not** being a well screen structure.

The Brockman reference, used in the Examiner's obviousness rejections of Claims 5, 6 and 89, specifically teaches, in FIG. 3 and its associated specification description, the placement of lines 166 in the **outermost** tubular member 21 of the telescoped tubular structure 21,40 as opposed to positioning the lines 166 in the **innermost** tubular structure 40 which is **nonperforated**. Thus, the Brockman reference also teaches directly away from making the Gano/Curlett reference combination being relied upon by the Examiner as the primary basis for rejecting all of the pending claims in this application.

As to the examiner-alleged motivation for making this combination, the examiner's logic is simply not supportable. For example, with respect to his contention that Curlett teaches the benefit of providing sensors, Curlett clearly does not teach or suggest any benefit of associating such sensors with lines extending through an **innermost** perforated tubular member disposed within another tubular member in an overall well screen structure. Further, since Gano teaches the **benefit** of placing lines **outside** of an innermost tubular member of a well screen structure in a manner that shields and **protects** such lines, the "line protection" motivation asserted by the examiner for making his proposed Gano/Curlett reference combination does not exist.

Thus, it clearly would **not** be obvious to make the proposed Gano/Curlett reference combination being proposed by the examiner.

Since the Gano/Curlett reference combination (present in all of the Examiner's claim rejections) clearly cannot be properly made for the reasons set forth above, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness of any of applicant's

Claims 5, 6, 8, 10, 15, 84, 85 and 87-97. Instead, the Examiner has clearly engaged in impermissible hindsight reasoning in piecing together various limitations in applicants' claims, using as many as **five** separate references in the case of the Claim 6 rejection, to arrive at applicants' claim limitations using the **applicants'** teachings instead of permissible teachings from the prior art.

The secondary Jones, Swearingen, Brockman, Miller, and Bearden references relied upon by the Examiner fail to cure the above-discussed deficiencies in Gano and Curlett with respect to embedding a line in the sidewall of the recited innermost perforated tubular member of applicants' well screen, having been cited by the Examiner for their alleged teachings with respect to other aspects of the claimed subject matter in the present application.

Thus, for the foregoing reasons it is respectfully submitted that Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 are patentably distinguishable over the Gano, Curlett, Jones, Swearingen, Brockman, Miller, and Bearden references, whether such references are considered singly or in any combination thereof.

In view of the foregoing amendment, remarks and arguments, all of the claims currently pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of Claims 5, 6, 8, 10, 15, 84, 85 and 87-97 is therefore earnestly solicited.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/516-0030 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,

KONNEKER & SMITH, P.C.

A handwritten signature in black ink, appearing to read "J. Richard Konneker", written over the printed name.

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Dated: February 9, 2004

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on February 9, 2004  
Diane Sutton